

REMARKS / ARGUMENTS

Claim Clarifications

Claims 13 –28 have been amended to replace "consumer" with "individual" in order to clarify the meaning of the claim and provide sufficient antecedent basis in the claims. In addition, claims 24 and 27 have been rewritten as independent claims in response to examiner's objection.

New Claims 29 - 38

New claims 29 through 38 are similar to claims 13 through 28 but include the additional limitation that the user attributes are known attributes provided by the originator of the information. For example, a school is a provider of information (e.g. student grades) as well as provider of demographic information associated to particular students. Support for this limitation is found in the specification on page 13, lines 5 – 8 and page 28, line 18 to page 29, line 7. Of the various attribute obtaining methods listed, this limitation refers to using known attributes residing in the same database of the information provider or in a cross-referenced database of the information provider.

In U.S. Patent 5,717,923 (Dedrick '923) and U.S. Patent 5,724,521 (Dedrick '521) the client system and metering system provide client attributes. The personal profile database 27 is part of client system 12 (see Figure 2 and Figure 1). Similarly user profile database 30 is part of metering server 14 (see Figure 3 and Figure 1). Publisher server 18 and Advertiser server 18 do not provide client attributes.

As a result and in addition to reasons below, new claims 29 through 38 are novel in comparison to Dedrick '923 and Dedrick '521 because they do not use publisher provided profile data that is known.

New Claims 39 - 44

New claims 39 through 44 are similar to claims 13 through 28 but include the additional limitations that the database of information is a limited access database containing information unique to the individual. For example, school grades, education records, medical records, employment records, financial records and tax returns are examples of information unique to an individual. Support for this limitation is found on page 5 of the specification wherein the database is to contain information desired by the consumer. Also on page 9 of the specification the example is given that student grades (i.e. unique to each student) are only delivered to the particular student in question.

In Dedrick '923 and Dedrick '521 the publisher and advertiser servers provide information to subscribers or categories of subscribers without knowing the identity of the subscribers. As described and illustrated in Figure 1 of the Dedrick patents, the client systems communicate to the publishers and advertisers only through metering servers 14. As described in Dedrick '923, information associated with an end user is compiled and transferred to metering server 14 *"without any indication of the identity of the user"* (Col. 3, lines 58-62). Similar disclosure is found in Dedrick '521 at Column 3, lines 50-54. The advertising server 18 and publisher server 18 connect through the metering servers and so are precluded from knowing the identity of a user unless a user first transmits their identity (for example to purchase an advertised item).

As the advertiser/publisher does not know the identity of a user at the time of transmitting its publication or advertisement, it is limited to transmitting information of a relatively general type and not unique to a single subscriber. This is in keeping with US Federal privacy laws that prevent transmission of information unique to an individual (privacy laws have exceptions depending upon the category of information).

As a result and in addition to reasons below, Claims 39 through 44 are novel over Dedrick '923 and Dedrick '521 because claims have the limitation of

identifying each user and providing information which can legally only be provided to the associated or authorized user.

Claim Rejections

Examiner has entered a 35 USC §103(a) obvious type rejection of claims 13 through 23, 25, 26 and 28 over U.S. Patent 5,717,923 to Dedrick (Dedrick '923) in view of U.S. Patent 5,737,533 to de Hond (de Hond '533). Applicant responds that the claimed invention, is distinguished from these references and therefore is not obvious over Dedrick '923 in view of de Hond '533 for the following reasons:

Dedrick '923 is closely related to U.S. Patent 5,724,521, also listing Rick Dedrick as the sole inventor ("Dedrick '521"). Both Dedrick '923 and Dedrick '521 were filed on November 3, 1994. Both patents share much of the disclosed specification. Figures 1, 2, 4, 5, 6a, and 7b. Dedrick Figures 3 are equal except that Dedrick '521 has an additional block 39 "Consumer Scale Matching Process." Figures 6b are equal except for "and" being inserted between the words "profile" and "billing" in block 118. Figures 7a are similar but have differences that relate to advertiser billing. Dedrick '923 has a Figure 8 that is not present in Dedrick '521. Due to this closeness, Dedrick '923 and Dedrick '521 will be referred to as the "Dedrick patents."

It is first noted that the title of Dedrick '923 is ambiguous in the use of the phrase "... for Customizing Electronic Information to Individual End Users." Multiple interpretations of "customizing" are possible. One interpretation is that an advertiser or publisher will customize and individualize advertisements for known individual end users. Another interpretation is that a user customizes the format and/or the selection of messages and advertisements in accordance with his or her preferences. A final interpretation is that the price an advertiser pays to transmit an advertisement is customized based upon the number and "quality" of users who view the advertisement.

Of these three alternative interpretations, only the first interpretation approximates "targeted advertising" as the concept is traditionally thought of. An advertiser identifies a target audience and transmits advertisements only to that audience. However, this interpretation is not in conformance with either of the Dedrick patents. Instead the Dedrick patents disclose examples and embodiments of "customizing" the user display format, user selections, and advertiser billing.

In column 4 of each of the Dedrick patents is described customizing user display formats based upon "consumer variables" that are embedded in an electronic newspaper or advertisement. Using the embedded variables, the user's content adapter can customize the color for viewing or the form of expression (i.e. audio vs. no audio, video, text only, etc.) In order to support the format selection the advertiser/publisher is provided with software tools for creating electronic content in a "wide variety of consumption formats." Content adapter 25 of the Dedrick patents is part of the client system and performs the formatting and user customizing (Figure 2).

Also described in the Dedrick patents is how the advertising bills are customized based upon who receives the advertisement. For example, a metering server 14 maybe connected to 1000 clients. When an advertisement is transmitted to all users connected to the metering server, a report is generated indicating how many users of each demographic criteria have received the advertisement. In Dedrick '521 the billing is directly associated to the "quality" of the viewers by using a "consumer scale." The higher the consumer scale, the higher the billing is to an advertiser.

The Dedrick patents provide three options to select who is to receive an advertisement or publication: 1) limited to subscribers of a publication; 2) selected for viewing by a user and 3) selected for viewing by appraisal agent 28. The latter two methods are directed by the user. The user can access an electronic "yellow pages" that may be indexed for his or her convenience.

Similarly, a user can program an appraisal agent to search multiple yellow page servers to obtain competitive prices for an item of interest.

Although an advertiser can attach or include an advertisement in an electronic publication, the Dedrick patents do not have provisions of selecting particular advertisements for a particular group of users. The only options an advertiser has is to select a publication that reaches a desired target audience and to determine how much to pay for viewing responses. This is much like print media where advertisers select which newspaper or magazine for placement of advertisement. Just as newspaper advertisements are not varied based upon target readers, Dedrick advertisements are not varied based upon target users.

In contrast to Dedrick '923 and Dedrick '521, the present invention targets advertisements based upon the attributes from an identified user. Individual users can receive advertisements targeted to them. Whereas the Dedrick patents change the advertising fees based upon the appropriateness of viewing users, the present invention changes which advertisements a particular viewing user will be exposed to.

The present invention is not analogous to the Dedrick patents as it does not claim or incorporate a content adapter to vary screen colors and format.

Due to the significant and essential differences between the present invention and the Dedrick patents, applicant respectfully requests the examiner to reconsider his preliminary findings. The combination of U.S. Patent 5,727,533 to de Hond does not address these differences, but rather better enable the use of the Dedrick apparatus in an Internet environment. As a result, it is applicants view that the present invention is novel and unobvious in view of Dedrick '923, Dedrick '521 and de Hond, either individually or when combined.

Noted in applicant's affidavit filed October 31, 1996 is a claimed priority date for this patent application of February 26, 1996 (based upon completion of invention). In addition, a later priority date of August 9, 1996 is established from the provisional patent applications to which this patent claims priority.

Appl. No. 09/420.002
Amdt. dated July 15, 2004
Reply to Office action of April 15, 2004

Although applicant has no knowledge of any undisclosed prior art, applicant has become aware that there may exist articles purporting to have publication dates between July 1995 and September 3, 1996 that may be material to this application. Applicant does not have knowledge of the contents of these articles and has not had access to these articles but apprises the examiner of their alleged existence in order to fully comply with rule 37 CFR 1.56. The articles are listed as "Other References" for U.S. Patent 6,285,987 to Roth *et al.*

Should any further questions arise concerning this application or in the event the above amendments do not place the application in condition for allowance, applicant respectfully requests a telephone or office interview. Attorney for the applicant may be reached at the number listed below.

Respectfully submitted,

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